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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,674

Applicant(s)

KIDO, YOKO

Examiner

Nabil M El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1-6 are pending in this application.
2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms, which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: p2, lines 1-2 "For example,....etc."; p2, line 6 "collect information with passive attitude"; p4 "without retrieving visually or extracting by specific programs"; p4, lines 12-15 "Moreover, by extracting ... and speedily"; p4, lines 23-24 "to retrieve and extract ... without any mistake"; p5, lines 1-5 "since information and speedily"; p6, line 23-27 "all the contents and information collected thereby are electronized into a computer" and "more than single character registered in advance"; p7, lines 10-13 "their own physical and spiritual characters as their key words" and for example, usually ..."; plus many others throughout the specification.
3. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following phrases are not clearly understood and render the claims vague:

- a) "with application of a means to ", claim 1, lines 2-3.
- b) "by the above method", claim 1, line 6, there is no method described in the claim, the claim is an apparatus claim, and "method of trade" is part of the preamble.
- c) "the above retrieval, extraction and summarization method", claim 1, line 9, there is no method described in the claim, the claim is an apparatus claim, and "method of trade" is part of the preamble.
- d) "the above method", claim 1, line 11, there is no method described in the claim, the claim is an apparatus claim, and "method of trade" is part of the preamble.
- e) "the above-mentioned contribution method", claim 1, lines 12-13, there is no method described in the claim, the claim is an apparatus claim, and "method of trade" is part of the preamble.
- f) "for all or partial application", claim 1, line 10.
- g) "with features", claim 1, line 10; claim 4, line 2; claim 5, line 2, claim 6, line 2.
- h) "the above-stated retrieval, extraction and summarization method", claim 2, line 4, there is no method described in claim 1, the claim is an apparatus claim, and "method of trade" is part of the preamble.
- i) "in the above CLAIM 1 method", claim 2, lines 8-9, there is no method described in claim 1, the claim is an apparatus claim, and "method of trade" is part of the preamble.
- j) "using the computer of the above CLAIM 1 by the computer", claim 2, lines 2-5.

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k) "e-mail as a device ... or television as device ..or home page as a device",
claim 2, lines 5-7.

l) "to obtain above-mentioned information or publications themselves", claim 3,
lines 2-3.

m) "those features thereof, claim 3, line 5.

n) "in the above CLAIM 1 or CLAIM 2 methods", claim 3, lines 5-6, there is no
method described in claim 1, the claim is an apparatus claim.

o) "summarized as above, in the above CLAIM 1 or CLAIM 2 or CLAIM 3
methods", claim 4, lines 5-6, there is no method described in claim 1, the claim is
an apparatus claim.

p)'all or a part of the means by the computer", claim 6, line 3.

q) " in the above CLAIM 1 or CLAIM 2 or CLAIM 3 or CLAIM 4 methods", claim 5,
lines 5-6, there is no method described in claim 1, the claim is an apparatus
claim.

r) "not only to ... but also to", claim 5, lines 2-4.

s) " in the above CLAIM 1 or CLAIM 2 or CLAIM 3 or CLAIM 4 or CLAIM 5
methods", claim 6, lines 3-4, there is no method described in claim 1, the claim is
an apparatus claim.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The claim is an omnibus type claim.

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6. A broad range or limitation together with a narrow range of limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "more than a single information", and the claim also recites "the contents of publications" which is the narrower statement of the range/limitation. Claim 1 recites the broad recitation "distribute more than once information collected", and the claim also recites "with the features to distribute more than once different information collected and summarized more than once" which is the narrower statement of the range/limitation.

7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

8. Claims 1-6 provide for the use of an apparatus to distribute information, but, since the claim does not set forth any steps involved in the method/process, it is unclear what

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method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

9. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

10. Claims 4, 5, and 6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 3 and 5. A multiple dependent claim should not depend on multiple dependent claim. See MPEP § 608.01(n).

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Handel et al. (US 6,195,651), hereafter "Handel".

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13. As to claim 1, Handel discloses the invention as claimed including an apparatus for information distribution system (col. 1, lines 53-61) with application of a means to collect more than a single information or the contents of publications made public or issued regularly or irregularly (col. 17, lines 56-58; col. 36, lines 59-67; col. 37, lines 24-33; col. 38, lines 2-3, 12-21; and 2500, 2502, 2504, Fig. 25), a means to make more than a single retrieval of more than a single word or phrase registered in advance out of more than a single information collected by the above method (col. 1, lines 53-61; col. 13, lines 16-20; col. 29, line 65 to col. 30, line 14; col. 31, lines 25-42; col. 37, lines 29-33) and summarize the result more than once (col. 35, lines 38-62) , a means to retrieve and extract more than once more than a single character registered in advance and summarize its result (col. 31, line 45-47; Fig. 12; col. 36, lines 44-48; col. 37, lines 29-33; and col. 40, lines 5-22) , a means to distribute more than once information collected by the above retrieval, extraction and summarization method through the computer for all or partial application (col. 1, lines 55-61; col. 37, lines 51-52; col. 38, lines 6-7; and Fig. 25) , and with features to distribute more than once different information collected and summarized more than once by the above method to more than an individual person or group/organization (col. 1, lines 55-61; col. 37, lines 51-52; col. 38, lines 6-7; and Fig. 25) .

14. As to claim 2, Handel discloses using the computer as a means to distribute more than once data and information collected and summarized (col. 1, lines 55-61; col. 37, lines 51-52; col. 38, lines 6-7; and Fig. 25), or e-mail (Fig. 25), or television, or home pages, or telephone, or mobile information terminals, or mobile phones (inherent in col. 40, lines 24-46).

15. As to claim 3, Handel discloses a means to obtain the information or publications to be retrieved or extracted (col. 31, line 45-47; Fig. 12; col. 36, lines 44-48; col. 37, lines 29-33; and

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col. 40, lines 5-22), and a means to obtain further information or make use of services based on the information or publications (e.g. col. 36, line 59 to col. 27, line 2; and col. 38, lines 13-21).

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Handel et al. (US 6,195,651), hereafter "Handel" in view of Dedrick (US 5,768,521).

18. As to claim 4, Handel does not specifically disclose collecting information distribution fees from more than an individual person or group/organizations or providers of information or publications who receive summarized information. Dedrick, on the other hand, discloses collecting information distribution fees (col. 1, line 65 to col. 2, line 10). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Handel and Dedrick because Dedrick's arrangement of collecting information distribution fees would streamline the functionality of Handel's information distribution system by allowing one of the agents to collect information distribution fees.

19. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handel et al. (US 6,195,651), hereafter "Handel" in view of Dedrick (US 5,768,521) and further in view of Ukita et al. (US 6,622,174), hereafter "Ukita".

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20. As to claim 5, Handel and Dedrick do not disclose attaching or adding advertisement or publicity to, or on the information to be transmitted, and collecting description fees from the advertisement or publicity providers. Ukita, on the other hand, discloses attaching or adding advertisement or publicity to, or on the information to be transmitted, and collecting description fees from the advertisement or publicity providers. It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Handel, Dedrick, and Ukita because Ukita's arrangement of attaching or adding advertisement or publicity to, or on the information to be transmitted, and collecting description fees from the advertisement or publicity providers would enhance the functionality of Handel-Dedrick's information distribution system allowing the system to offer information distribution with low cost to the user by providing advertisements paid by the provider (see, for example, Ukita, col. 1, lines 44-51).

21. As to claim 6, it is inherent in the disclosures of Handel, Dedrick, Ukita, that a computer software device is utilized to carry out all or a part of the means by the computer.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dedrick (US 6,151,600); Vanderveldt et al. (US 6,266,668); Okumura et al. (US 6,178,424) ; Binder (US 6,513,052); Bracho et al. (US 6,021,443); Fields et al. (US 6,347,943); Dedrick (US 5,710,884); Melchione et al. (US 5,930,764); Gerace (US 5,848,396); Schummer (US 2001/0032154); Gupta et al. (US 2001/0020242); and Smith et al. (US 2002/0010625).


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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 5, 2004



Nabil El-Hady, Ph.D, M.B.A.
Primary Patent Examiner
Art Unit 2154